

## REMARKS/ARGUMENTS

On page 2 of the Office Action, the Examiner rejected claims 6-10 under 35 U.S.C. 112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 6-10 have been amended in order to clear the indefiniteness from its respective limitations, and thus should be allowable. Accordingly, the claims should be in condition for allowance.

### **Rejections under 35 U.S.C. § 103**

On page x of the Office Action, the Examiner has also rejected claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over Vogel in view of Frazzell et al. (5,263,389).

Applicant respectfully traverses the rejections. Applicant respectfully submits that the combination of these references is not proper, as the references do not provide a motivation to combine them. Even if properly combined, the combination does not render the claims obvious. At the outset, there is no motivation within the references to combine them. Vogel discloses a system for visually coding tools as to their size comprising a maximum of two sets of differently colored bands that are placed on the surface of the tool. Each band of each color represents a portion of the size of the tool. Specifically, this construction allows for each type of indicator to denote a different discrete predetermined increment of size by which the tool is measured in relation to other tools in said tool set. Additionally, different colors are used to indicate metric tools versus English tools.

The Examiner states that it would be obvious to take the wrench of Vogel with the specific gravity taught by Frazzell et al. to arrive at Applicant's invention (Office Action, page 3). However, there is no motivation to seek an improvement in the wrench for Vogel, which discloses a system for visually coding tools as to their size comprising a maximum of two sets of differently colored bands that are placed on the surface of the tool. In particular, Vogel fails to disclose either a floating wrench or a floating wrench having reflective material or luminescent material arranged on the body of the wrench. Thus, there is no motivation to combine the numerous sized wrenches of Vogel with the single size propeller wrench of Frazzell et al., as the combination would result in a wrench that is contrary to the disclosure of Vogel to have a color-coding system for visually coding tools as to their size. Therefore, these references teach away from combining them.

Further, Applicant submits that the propeller wrench of Frazzell et al. would result in a wrench that lacks color-coding in favor a floating member. Therefore, Vogel fails to provide an enabling disclosure for a floating member and does not provide sufficient disclosure for providing a reflective material arranged on the floating member. Applicant's invention, and specifically the combined use of a buoyant body with reflective material arranged thereon, shows a dramatically improved buoyant wrench when compared with the sized wrenches disclosed in Vogel.

Even if these references were properly combinable, Vogel alone or in combination with Frazzell et al. does not disclose or render obvious Applicant's invention. Specifically, this combination of references and the reasons given by the Examiner for the combination do not disclose what is required by the Applicant's claims

– a body positioned adjacent to a first engagement end, the body incorporating a reflective material. This combination also does not teach or suggest a wrench expressly or inherently having the claimed requirements of Applicant's buoyant wrench. It is advantageous to provide a wrench for aquatic use that is buoyant and has reflective or luminescent material that is arranged on the wrench body. One advantage to using the reflective or luminescent material of the present invention is that the reflective or luminescent material will permit the user to more easily identify the location of the buoyant wrench, should the buoyant wrench fall into the water. (Page 5, line 19 to page 6, line 4).

The wrenches of Vogel could not be used to provide a buoyant wrench, and incorporated reflective material, resulting from the use of a material having a specific gravity of less than 1.0 and the reflective material. Thus, the wrench of Vogel is unsuitable.

The Examiner has failed to establish a prima facie case for obviousness of claims 1-11. It is the Examiner's burden to show that the prior art relied upon coupled with the knowledge generally available in the art at the time of the invention must contain a suggestion or incentive that would have motivated one of ordinary skill in the art to combine references. As Applicant has set forth throughout this response, the distinctive differences between the individual references makes the combination of these references implausible. The Examiner must also show that the proposed combination must have a reasonable expectation of success. It is inappropriate for the Examiner to use the present application as a motivation to combine the references. This inappropriate combination, taking bits and pieces from each reference in an attempt to create Applicant's invention,

is exactly what the Examiner has done with these references.

Therefore, since Vogel, in view of Frazzell et al. fails to teach or disclose a buoyant wrench, including reflective material thereon, Applicant respectfully submits it does not anticipate or render obvious any of the pending claims.

Thus, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection as to these claims.

### Conclusion

Having analyzed the rejections cited against the claims, it is urged that the present claims are in condition for allowance. A favorable reconsideration is requested. The Examiner is invited to contact the undersigned attorney to discuss any matters pertaining to the present application.

A marked version of the amended claims showing where changes have been made is attached hereto.

Respectfully submitted,

Date:

By:   
Jordan A. Newmark, Reg. No. 50,904  
RUDEN, McCLOSKY, SMITH,  
SCHUSTER & RUSSELL, P.A.  
200 East Broward Boulevard  
Fort Lauderdale, Florida 33301  
Tel.: (954) 527-6252  
Fax: (954) 333-4252

### Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:  
Commissioner for Patents, P.O. Box 22313, Alexandria, VA 22313-1450 on

10/15/04  
Shulman

Date:

10/15/04